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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,796	12/20/2000	Robert H. Montgomery JR.	K-1744	8446

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EXAMINER

KRECK, JOHN J

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 08/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/742,796

Applicant(s)

MONTGOMERY, ROBERT H.

Examiner

John Kreck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-11, 13 and 15-35 is/are pending in the application.
- 4a) Of the above claim(s) 29-35 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5-11, 13 and 15-22 is/are allowed.
- 6) ☒ Claim(s) 23-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

1. In view of the appeal brief filed on 6/24/03, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

- 2. The amendment dated 4/21/03 has been entered.
- 3. Claims 1-3,5-11,13,15-35 are pending.
- 4. Claims 29-35 remain withdrawn as being drawn to a non-elected invention.

### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 16 (page 7, first paragraph). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Sterwerf, Jr. (U.S. Patent number 5,370,448).

Sterwerf shows a wear sleeve including an annular groove (31) adapted to receive a generally cylindrical retainer; a forward tapered portion; and a shoulder (near 14); wherein the tapered portion is between the groove and the shoulder and the tapered portion is spaced from the shoulder (by cylindrical portion 21) as called for in claim 24. Note that the term “generally cylindrical” is interpreted broadly to encompass short cylinders (the ring shown by Sterfwerf might be considered a short cylinder) and elongated cylinders (such as shown by US 4582364 or US 6099081).

Sterwerf also shows the retainer (32) as called for in claim 26.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 23, 25, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sterwerf in view of Bitelli (U.S. Patent number 6,086,160).

Sterwerf shows a wear sleeve (2) comprising an external portion and a portion that is adapted to be received in a bit holder; the portion that is adapted to be received including a rearward disc end portion (22), an annular groove portion (31) adapted to receive a generally cylindrical retainer and a forward tapered portion; wherein the sleeve has a shoulder (14). Sterwerf fails to show the rounded undercut portion.

Bitelli shows a similar sleeve which includes a shoulder and rounded undercut portion which weakens and fails first, which prevents the sleeve from breaking in the bore.

It would have been further obvious to one of ordinary skill in the art at the time of the invention to have further modified the Sterwerf sleeve to have a shoulder and rounded undercut portion which weakens and fails first, as called for in claim 23, in order to prevent the sleeve from breaking in the bore.

With regards to claim 25; Sterwerf teaches all of the limitations of claim 24, from which this claim depends. Sterwerf fails to show the rounded undercut portion.

Bitelli shows a similar sleeve which includes a shoulder and rounded undercut portion which weakens and fails first, which prevents the sleeve from breaking in the bore.

It would have been further obvious to one of ordinary skill in the art at the time of the invention to have further modified the Sterwerf sleeve to have a shoulder and

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rounded undercut portion which weakens and fails first, as called for in claim 25, in order to prevent the sleeve from breaking in the bore.

With regards to claim 27; Sterwerf shows the retainer (32).

With regards to claim 28; Sterwerf shows the retainer (32) positioned around the groove.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

9. Claims 1-3,5-8,10,11,13,15,16, and 18-22 are allowed.

10. The following is an examiner's statement of reasons for allowance: the closest prior art includes Ritchey, which teaches a non-rotatable, generally cylindrical wear sleeve which is held in place by a retainer (142); and LeBegue, which teaches a non-rotatable tapered bit assembly which uses a retainer (52) to provides a positive downward force to the assembly. The principle of operation of the LeBegue system is sufficiently different from the principle of operation of the Ritchey system that one of ordinary skill in the art would not have found motivation to combine the teaching of LeBegue with the Ritchey system.

11. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kreck whose telephone number is (703)308-2725. The examiner can normally be reached on M-F 6:00 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703)308-2978. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-4177.



HEATHER SHACKELFORD  
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JJK  
July 31, 2003